

### Remarks

Applicant first wishes to thank the Examiner for withdrawing the restriction requirement set forth in the earlier Office Action. As a result, each of original claims 1-21 remain pending in the present application. By this Amendment, independent claims 1, 15 and 21, and dependent claim 3 have been amended.

The Examiner has rejected claim 3 under 35 U.S.C. § 112, second paragraph on the basis that the term “comparable” is vague. Applicant has amended claim 3 to remove that term, and to more clearly recite that the effective surface area in the first position is “substantially greater” than in the second position. Applicant believes that these amendments fully overcome the Examiner’s rejection

The Examiner has also rejected each of claims 1-6 and 9-21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,472,442 to Klicek (“Klicek”). Applicant respectfully disagrees with the Examiner’s rejection, but in the interests of expediting allowance of the claims has amended each of independent claims 1, 15 and 21 to further distinguish over the cited reference. In particular, independent claim 1 has been amended to recite a movable converting element that, when in the first position, is in electrical contact with the active electrode and not the return electrode *so as to form part of the active electrode thereby increasing an effective surface area of the active electrode relative to the return electrode*. Further, when in the second position the converting element is not in electrical contact with the active electrode *thereby decreasing the effective surface area of the active electrode relative to the return electrode as compared to the first position*. Finally, amended claim 1 now specifically recites that the instrument *uses bipolar energy in both the first and second positions*.

As stated by the Examiner, Klicek discloses an electrosurgical instrument having various features that enable it to be used either as a bipolar *or monopolar* instrument. In contrast, the present invention provides an electrosurgical instrument that is used in two different bipolar modes, with the difference between the two bipolar modes being the effective surface area of the active electrode relative to the return electrode. This enables optimal use for cutting, where it is desirable to have an active electrode having a much smaller surface area relative to that of the return electrode, and for coagulation, where the active surface ratios should be more balanced.

Klicek does not disclose or suggest a instrument having a converting element, the movement of which changes the effective surface area of the active electrode relative to the return electrode, and which is operated in bipolar mode in both states as is presented recited in amended claim 1. Thus, as Klicek fails to teach or suggest many features now recited in amended claim 1, applicant respectfully submits that Klicek does not anticipate claim 1 or any of claims 2-14 which depend therefrom. Reconsideration and allowance is respectfully requested.

Similar claim amendments have been made to both independent claim 15 and independent claim 21. As such, for the reasons stated above in connection with claim 1, applicant believes that claims 15 and 21, and claims 16-20 which depend from claim 15, are also patentable over the cited reference.

In view of the foregoing, reconsideration and allowance of pending claims 1-21 is respectfully requested.

Applicants believe that no fee is due in connection with this response. The Commissioner is hereby authorized, however, to charge any additional fees that may be required to Account No. 10-0750/GYN-5004/MJS. This Authorization is being submitted in triplicate.

Respectfully submitted,  
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